



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	§	
	§	
JIM J. MILLER ET AL.	§	Attorney Docket: Miller-001;CIP
	§	
Serial No.: 10/730,431	§	Examiner: Kurt C. Rowan
	§	
Filed: December 8, 2003	§	Art Unit: 3643
	§	
For: IMPROVED AUTOMATIC FISH	§	
HOOK AND METHOD OF USE	§	

REPLY BRIEF TO AN EXAMINER'S ANSWER UNDER 37 C.F.R. 41.41

**COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450**

Sir:

Appellants hereby submit this Reply Brief, under 37 C.F.R. 41.41, to the Examiner's Answer, mailed June 29, 2006. This being in furtherance of the Notice of Appeal under 37 C.F.R. 1.191 and filed June 24, 2005, and the Amended Appeal Brief under 37 C.F.R. 41.37 and filed December 21, 2005 to the Board of Patent Appeals and Interferences, to appeal the decision of the Examiner of the Final Rejection of Claims 1-15 and 17-20, for the above designated application. Appellants hereby submit the information and arguments are in conformance to 37 C.F.R. 41.41.

(1) Claims Appendix

The Appellants acknowledge the Examiner's statement regarding the correct set of claims, under appeal, being the claims filed November 29, 2004.

(2) Response to Examiner's Response to Argument

This Reply Brief incorporates, by reference, each and every paragraph of the Amended Appeal Brief, filed December 21, 2005, as if specifically set out herein.

The Examiner alleges that reciting a catch, integral to the first shank does not limit the claim to one catch, since there merely has to be at least a catch integral to the first shank which is shown by Schaefer. The Examiner bases this construction, of the claims, on the Appellants' use of the term "comprising". However, the Appellants' particular claim limitation reads "a

catch, integral to said first shank, comprising an offset disposed about said first shank, and releasably in communication with said second shank.” Thus, Appellants respectfully submit that the term “comprising” modifies or describes what the “catch” comprises and not what the “shank” comprises. It is submitted that Appellants’ claim recites having a catch integral to the first shank and that **the catch** comprises an offset. Neither Danielson nor Schaefer, alone or in combination teach, disclose, or even suggest just having a catch, formed from the shank, to hold the shanks cocked. Further, Appellants respectfully submit that neither Danielson nor Schaefer, alone nor in combination teach, disclose, or even suggest that the catch comprises an offset. Danielson has no offset in the shank and the Schaefer catch 6 is a pin or protrusion which is welded onto the shank or otherwise mechanically connected to the shank. Appellants further submit that the Schaefer catch 6 is not integral to the shank (i.e. part of the single wire that forms the hook), in the same manner as claimed by the Appellants, but is added to the shank during manufacturing. However, the Appellants stand ready to amend the claim language, should the Board authorize such amendments, as follows: “said first shank having an offset such that said offset is bent and/or curved the width of the coil; said offset being a single catch, integral to said first shank and releasably in communication with said second shank”.

The Examiner alleges that the Applicants argue how the hook functions when all the claims are article/apparatus claims. Applicants respectfully submit that the function of the instant hook should be explained in order to clarify how the claimed elements are distinguishable from the prior art. The Examiner alleges that the mere replacement or interchanging of parts (such as the Schaefer catches on the Danielson shanks) will make the instant invention obvious. However, Applicants discuss the function to show that these elements are not interchangeable and that the hook that the Examiner alleges can be made from a combination of Schaefer and Danielson is simply unworkable, at least not without undue experimentation.

The Examiner states that because Schaefer fails to discuss any pulling force required to set the hook that it would be inherent that a device of Schaefer and Danielson would also only require the forces of the fish biting to set the hook. However, Applicants respectfully direct the Board’s attention to the fact that Danielson, specifically at lines 62-67, discloses that when the fish grabs the bait, the fishing line becomes taut and in turn gives a sudden jerk to the hooks which become released. However, Appellants respectfully submit that if a fish bites the Danielson hook and swims toward the fishing pole (i.e. wherein slack remains in the fishing line)

the Danielson hook will not be set even when combined with the Schaefer catch 6.

In sharp contrast, the Appellants' hook will set (i.e. be released from the second position) upon the application of two generally opposing forces by the interior of the fish's mouth, applied about said first shank and said second shank **without** any pulling motion on the line by the fish or the fisherperson. Merely replacing the Danielson catches with the Schaefer catches will not alter how the Danielson device works i.e. it will still **not automatically set**, as the device claimed by the Appellants, even with the Schaefer catches.

The Examiner alleges that Schaefer shows that the catches 6,6 are bent or curved about the width of the coil spring. This is simply incorrect. The Schaefer shanks 1 remain substantially in the same plane whether cocked or uncocked. They are never offset by the width of the coil spring (Schaefer does not have a coil spring but uses a leaf spring 7). Further, the Schaefer catches are not bent or curved. The Schaefer catch 6 is a pin or protrusion which is welded onto the shank or otherwise mechanically connected to the shank.

In sharp contrast, the Appellants' offset catch is a bend or curve in the shank. The shank is bent in a substantially perpendicular angle, it extends in that direction a distance substantially equal to the width of the coil spring, curves or bends in a substantially perpendicular manner, and places the distal end of the shank in substantially the same plane as the other shank. *See* Appellants' Fig. 6. Thus, even the combination of Danielson, with the Schaefer catches 6, does not cause the distal end of the shank, having the catch, to be in substantially the same plane as the other shank (i.e. there is no perpendicular bend or curve in the Danielson, the Schaefer, or the combined Danielson/Schaefer hook).

The Examiner cites *In re Fine* and *In re Jones* to support the proposition that Schaefer and Danielson can be combined because the motivation to combine is found in the knowledge generally available to one of ordinary skill in the art. However, in *Fine*, the court specifically found that the particular facts did not support the combining of references. The court stated "But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination."'" *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596 (Fed. Cir. 1988) (quoting *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933). And "teachings of references can be combined only if there is some suggestion or incentive to do so." *Id.* The court further stated "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of

record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596 (Fed. Cir. 1988) (quoting *W.L. Gore*, 721 F.2d at 1553, 220 USPQ at 312-13).

Similarly, in *Jones*, that court found that the Patent Office showed no evidence, only speculation, that one of ordinary skill would be motivated to combine the cited references. *In re Jones*, 958 F.2d 347, 351, 21 USPQ2d 1941 (Fed. Cir. 1992).

Further Appellants respectfully repeat the argument that there is absolutely no motivation provided in either Schaefer or Danielson to combine their teachings. Danielson teaches a single wire hook that relies on an outside catch (7) to maintain the device cocked and thus preventing the device from being automatically set. Schaefer teaches a multi-part hook assembly that cannot possible be made from a single wire. The release mechanism of Schaefer (the interaction between the leaf spring 7 and the shanks 1) is completely different from the Danielson device. The leaf spring (7) of Schaefer must be separate from the shanks (1). To set and/or release the Schaefer device requires that the shanks (1) move within the leaf spring (7) or more likely that the leaf spring (7) must move into or out of the notched areas (10). Danielson discloses a coil spring. Therefore, combining a single wire Danielson hook and a multi piece Schaefer hook would not be considered by one skilled in the art. Further, there can be no reasonable expectation of success and thus no motivation to combine because Schaefer must be multi-part to work as taught and thus Schaefer would be destroyed and could not work if it were made from a single wire. Similarly, the Danielson hook would be destroyed if it required the addition of a separate coil/spring assembly. As such, no one skilled in the art would be motivated to combine Schaefer and Danielson to create a single wire fish hook without resorting to impermissible hindsight.

Still further, the *Fine* court found that the Board failed to appreciate that the appealed claims can be distinguished over the otherwise improper combination. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596 (Fed. Cir. 1988). This is the case here wherein Claims 1, 15, 17, each claim a second state, the cocked state, wherein the first and second shanks are crossed **one time**. Both Danielson (Figure 2) and Schaefer (Figure 1) show that the shanks are crossed **twice** in the cocked position. Further, Claim 15 adds a third state, (a possible set state) wherein the shanks are crossed twice but only after the hooks are set. This is indeed distinguishable as the Appellants’ research and expense have revealed these states as being necessary for a workable

fully automatic hook which will resist deploying until caught by a fish.

The Examiner alleges that the Appellants argue against obviousness merely based on the fact that the release mechanism of Schaefer cannot be physically incorporated into the Danielson device. Appellants respectfully disagree with the Examiner's simplification of the Appellants' argument. The release mechanism (of Schaefer), referred to by the Appellants, is the co-operation of the leaf spring 7 and the shanks 1. The fact that there can be no physical incorporation is evidence that one skilled in the art would treat the Danielson and Schaefer hooks as incompatible and who would not be motivated to combine any parts of them and further, as neither Schaefer nor Danielson, themselves, suggest any motivation for combination, one skilled in the art would never consider combining any parts of Schaefer and Danielson to create a new hook.

Further, the Danielson catch relies on multiple parts to maintain the hooks in the cocked position even if the Schaefer catch 6 is incorporated in the Danielson shanks. Even after adding the Schaefer catches 6 to the Danielson shanks, pin 7 would exist and would make the catch several pieces. If pin 7 was removed, there are no teachings or disclosure that the hooks would function in the same manner. Thus, by substituting the Schaefer catches 6 and removing the Danielson post 7, one skilled in the art could not be sure that such a combination would work without requiring undue experimentation. Further, the Appellants' one piece hook, with an integral catch that is actually part of the single wire hook was developed through extensive research, prototype development, and testing. Thus, money, time, and manpower were invested to create a functional, simple, one-piece, automatically setting hook, that was commercially viable. The placement of the integral catch is an important manufacturing step and must be done without damaging the rest of the hook.

In sharp contrast, the Schaefer shanks are substantially small flat bars that are independent of each other and are thus independently fabricated. Thus, creating a surface to insert, weld, or otherwise attach a pin or other metal onto the shank to create the catch 6. However, the welding or mechanical attachment of the catch 6 to the Danielson shank may be difficult or impossible as the Danielson shank is a wire (i.e. no flat surface area like Schaefer) and since both the Danielson shanks are part of the same wire, it may damage the other shank when attempting to attach a Schaefer catch to the other shank. Thus, again there would be no motivation to combine Schaefer and Danielson as too much uncertainty would exist regarding

the success of the combination and too much experimentation may be necessary to have a successfully working combination.

Appellants note the Examiner's final paragraph of the Response to Argument section (page 5 of the Examiner's Answer) wherein the Examiner responds to the Appellants argument that Danielson is non-analogous to the present invention. Appellants respectfully disagree with this characterization of Appellants' arguments. Appellants have not argued that Danielson is non-analogous art. Appellants have argued that the Appellants' device is distinguishable from Danielson because the Danielson device is not a single wire, automatically setting fish hook. Specifically, Danielson does not disclose a catch being integral to a first shank and the catch being an offset in the first shank. In previous Office Actions, the Examiner had taken the stand that Danielson teaches an integral catch 6. Appellants respectfully pointed out, in their Response/Amendment, filed November 29, 2004, that Danielson further requires a post or pin 7 which is **not** a part of the hook but is a part of a **separate** inanimate life-like fish bait 1. The post or pin 7 is required to hold both hooks (and both curved areas 6) in the crossed position. Thus, Danielson did not disclose a single wire fish hook with an integral catch that is formed in the same single wire but instead relies on an element separate from the single wire hook to keep the hooks in the cocked position. Further, a pull or setting action, by the fish swimming away or the fisherman setting the hook is required. There is **no automatic set** with Danielson.

In sharp contrast, the Appellants' device is a single wire hook having the catch formed in the single wire and capable of being set without any pulling of the fishing line by either the fish or the fisherperson.

Regarding Claim 20, Appellants respectfully submit that the Examiner has never specifically addressed Claim 20 in a separate rejection. Claim 20 was added in an Office Action Response filed November 29, 2004. Claim 20 was first rejected in the Final Office Action dated February 24, 2005. Claim 20 was rejected along with Claims 1-15 and 17-19 as being unpatentable over U.S. Patent No. 1,638,923 to Danielson in view of U.S. Patent No. 2,748,521 to Schaefer. However, no specific comment, by the Examiner, was directed to Claim 20 individually.

Neither Danielson nor Schaefer, alone or in combination, disclose a second member having an offset, such that the offset is bent and/or curved the width of the coil. Neither Danielson nor Schaefer, alone or in combination, teach, disclose, nor suggest that this offset is

used to hold the first member adjacent to the second member when the hook is in its cocked state. Claim 20 further recites that the fishhook is cocked such that when the fish bites or grabs the hook, the force of the fish's mouth overcomes the offset catch and allows the hooks to spring into their set position. Danielson and Schaefer cannot be combined to teach the disclosure of the instant application for reasons explained hereinabove and because neither reference teaches a single wire fish hook with an integral catch. Further neither reference teaches that the end of the second member, because of the offset is longitudinally positioned on the opposite side of the coil than is the straight portion of the second member.

Appellants' device, the automatic fish hook, is clearly patentable over all the prior art that the Examiner has cited in the prosecution of this application including Danielson and Schaefer. As such, Appellants respectfully submit that Claims 1-15 and 17-20 stand in condition for allowance and respectfully solicit that this application be advanced to issue.

Although Appellants believe that no additional fees are required, beyond the fees set forth under 37 CFR 42.20(b)(3) and included with the concurrently filed Request for Oral Hearing under 37 C.F.R. 41.47, the Commissioner is hereby respectfully authorized to deduct such additional fees or refund any overpayment, as might be required, from or to Deposit Account Number 13-2166.

Respectfully submitted,



Taras P. Bemko
(Registration No. 52,609)
The Matthews Firm
(Customer # 021897)
2000 Bering, Ste. 700
Houston, Texas 77057
(713) 355-4200 - Telephone
(713) 355-9689 - Facsimile

Date: August 29, 2006